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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/929,279   | 08/15/2001  | Keisei Yamamuro      | 742406-10           | 8203             |
| 22204  | 7590        | 04/16/2004           | EXAMINER            |                  |
| NIXON PEABODY, LLP<br>401 9TH STREET, NW<br>SUITE 900<br>WASHINGTON, DC 20004-2128 |             |                      | RAY, GOPAL C        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2111                |                  |

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/929,279

Applicant(s)

YAMAMURO ET AL.

Examiner

Gopal C. Ray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-19 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19 and 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4 and 6.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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1. The examiner acknowledges the election of Group II, claims 17-19 and 21-31 by a response filed on 3/29/04. Applicant should cancel non-elected claims 1-16 and 20. Claims 17-19 and 21-31 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The examiner believes that the title of the invention is broad. Applicant should include "electronic mail" feature in the title of the invention. A descriptive title indicative of the invention will help in proper indexing, classifying, searching, etc. See MPEP 606.01. However, the title of the invention should be limited to 500 characters.
3. The drawings filed on 8/15/01 are acceptable by the examiner. Direct any inquiries concerning drawing review by the USPTO draftsman to the Drawing Review Branch at (703) 305-8404.
4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Furthermore, all claims should be revised carefully to eliminate all grammatical errors and antecedent basis problems.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 17-19 and 21-31 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,978,836 issued to Ouchi.

As per claim 17, the reference of Ouchi teaches "a body region describing content of the electronic mail" in Fig. 24, "E-MAIL"; "an auxiliary region describing data

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necessary for transmitting the electronic mail" in Fig. 24, element "LOCATION TABLE"; "wherein operational control data for controlling an operation mode of the receiving device is included in the auxiliary region" in col. 17, lines 13-28.

As per claim 18, the reference of Ouchi teaches "a computer readable storage medium for storing the electronic mail data" in Fig. 3, element 32.

As per claim 19, the reference of Ouchi teaches "wherein the operation control data is data for controlling a user interface of the receiving device" in col. 7, lines 8-17.

As per claims 21, 22, 25 and 29, the claims are rejected for similar reasons as discussed in the rejection of claim 1 with the exception of "a user interface". However, the reference of Ouchi teaches the feature in col. 7, lines 8-17.

As per claims 24, 27 and 30, the claims are rejected for the same reasons as discussed in the rejection of claim 18.

As per claim 28, the reference of Ouchi teaches the added limitation in col. 8, lines 3-37.

As per claims 23, 26 and 31, the claims recite methods which parallel apparatus claim 21. In teaching the construction and use of the device, US Patent 5,978,836 issued to Ouchi teaches corresponding methods.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is urged to consider the references. The prior art submitted by applicant has been considered by the examiner and made of record in the file.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The new fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [mark.rinehart@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.

  
GOPAL C. RAY  
PRIMARY EXAMINER  
GROUP 2000